



PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number:
040894-5994-US

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Name _____

Application Number:
10/761,386

Filed:
January 22, 2004

First Named Inventor:
Hideaki FUNAKOSHI et al.

Art Unit:
2627

Examiner:
Vanessa V. Coleman

Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages are provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
- ☒ attorney or agent of record.
Registration number 48,125
- ☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Signature

Kent Basson

Typed or printed name

202-739-5705

Telephone number

September 27, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.



Response Under 37 C.F.R. § 1.116
Expedited Procedure
Examining Group 3000

PATENT
ATTORNEY DOCKET NO.: 040894-5994

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Hideaki FUNAKOSHI et al.)	Confirmation No.: 3093
)	
Application No.: 10/761,386)	Group Art Unit: 2627
)	
Filed: January 22, 2004)	Examiner: Vanessa V. Coleman
)	
For: OPTICAL PICKUP)	

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop AF
Randolph Building
401 Dulany Street
Alexandria, VA 22314
Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

In response to the Final Office Action dated May 31, 2007 and the Advisory Action dated September 12, 2007, Applicants respectfully request a Pre-Appeal Brief for Review of the pending rejections. A Notice of Appeal is filed concurrently herewith. Claims 1-4 and 7 are rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,748,580 to Matsui ("Matsui") in view of U.S. Patent No. 6,069,867 to Ikegame ("Ikegame"). Claims 5 and 6 are listed in the Advisory Action as objected to, although those claims were allowed in the Final Office Action dated September 12, 2007. Applicants respectfully submit that the final rejection of claims 1-4 and 7 under 35 U.S.C. § 103(a) is improper for the following reasons.

The Office Action of May 31, 2007 stated that “it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the attaching means of Matsui to be... attached at different distances as taught by Ikegame... .” Applicants would again like to draw the Examiner’s attention to the fact that the leaf springs of Ikegame are disclosed as being attached to the supporting means at the same distance rather than the different distance recited (for the wires rather than leaf springs) in claims 1, 2, 6, and 7. Applicants Col. 10, lines 5 and 6 of Ikegame state that the “[e]ffective lengths l_a and l_b of the leaf springs 6 and 7 are equal to each other” As shown in Fig. 12 of Ikegame, l_a and l_b are the distances from the attachments to the stationary (supporting) member 8 to the attachments to the holding member 2.

The Advisory Action asserts that the specification of Ikegame discloses that the leaf springs are attached to the supporting means at different distances, citing col. 9, line 66 to col. 10, line 3. However, the cited passage discloses no such thing. Instead, the specification discloses that the lower leaf spring 7 is arranged to be closer to an optical axis of the objective lens 1 than the upper leaf spring 6 by a distance δ” In the same paragraph, Ikegame explains that the “lengths l_a and l_b of the leaf springs 6 and 7 are equal to each other... .” Fig. 12 clearly shows that lengths l_a and l_b are the distances between the stationary member 8 and the holding member 2.

One of the three requirements for establishing a *prima facie* case of obviousness, as clearly explained in MPEP § 2143, is that “the prior art reference (or references when combined) must teach or suggest all the claim limitations. The Office Action of May 31, 2007 correctly states that “Matsui also does not disclose that the first, second and third wires are soldered to the substrate at different distances from the attaching means... .” As explained above, Ikegame also

does not disclose the feature of wires (or leaf springs – accepting for the sake of argument the assertion in the Advisory Action that “leaf springs and wires are art-recognized equivalents, used for the same purpose of supporting a lens”) being attached to the supporting means at different distances from the attaching means as recited in claims 1, 2, 6, and 7.

The Advisory Action further asserts that a person of ordinary skill in the art would be prompted to combine Matsui and Ikegame because “leaf springs and wires are art-recognized equivalents, used for the same purpose of supporting a lens... .” Applicants again assert that leaf springs and wires are not equivalent because the leaf springs of Ikegame allow motion only in the focusing direction, while the mounting wires of Matsui allow focusing and tracking movement. (Matsui at col. 8, lines 54-55 and col. 9, line 17.) Thus, applicants respectfully assert that a person of ordinary skill in the art would not be prompted to combine Matsui and Ikegame.

For at least the above reasons, Applicants submit that independent claim 1, independent claim 2 and its dependent claims 3-4, and independent claim 7 are in condition for allowance. Allowance of claims 1-4 and 7 is earnestly solicited. Applicants also respectfully request that allowance of claims 6 and 7 be reinstated, also.

In view of the above, Applicants respectfully assert that the rejection of claims 1-4 and 7 under 35 U.S.C. § 103(a) is improper and should be withdrawn.

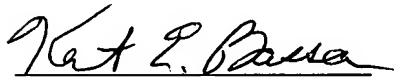
In view of the foregoing, Applicants respectfully submit that the rejections made in the final Office Action and Advisory Action are in error and therefore should be withdrawn. If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R.

1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

Dated: September 27, 2007

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